

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FERMIN ADAMES

Appeal No. 1998-1081
Application No. 08/462,202

HEARD: OCTOBER 10, 2000

Before BARRETT, RUGGIERO, and LALL, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-10 and 22-29. Claims 11-21 and 30-33 have been withdrawn from consideration by the Examiner as being drawn to a non-elected invention.

The claimed invention relates to a housing for an electric motor which is integrally formed with a conduit

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embedded in the housing for carrying a circulating heat removal fluid. The housing has a substantially cylindrical wall formed of a thermally conductive material with the fluid carrying conduit being disposed within the housing wall and in thermally conductive contact with the wall material.

Claim 1 is illustrative of the invention and reads as follows:

1. A housing for an electric motor comprising:

a substantially cylindrical cast housing wall formed from a thermally conductive material; and

at least one fluid-carrying conduit embedded in said housing wall;

said conduit having a tubular conduit wall distinct from said housing wall and in thermally conductive contact with said housing wall.

The Examiner relies on the following prior art:

Bone	4,516,044	
May 07, 1985		
Molitor	4,540,045	Sep.
10, 1985		

Claims 1-10 and 22-29 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Bone in view of Molitor.

Rather than reiterate the arguments of Appellant and the

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Examiner, reference is made to the Brief and Answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-10 and 22-29. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In

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so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's obviousness rejection of independent claims 1, 2, 7, 8, 9, 10, and 22, Appellant

asserts (Brief, pages 9 and 10) that the Examiner has failed to establish a prima facie case of obviousness since none of the references suggest any reason why they might be combined. Further, Appellant asserts that, even if the references could be combined, the resulting combination would not meet the requirements of the claimed invention.

After careful review of the applied prior art in light of the arguments of record, we are in agreement with Appellant's position as stated in the Brief. The distinct fluid conduit wall structure disclosed by Molitor, which the Examiner has suggested could be utilized in place of the grooved channel fluid passageways in Bone, would serve no purpose in the structure of Bone. As pointed out by Appellant, Bone's wall member, which is made of solid material, serves to contain the heat transfer fluid, thereby obviating the need for a distinct conduit wall structure. Further, we fail to see how the heat exchange structure of Molitor, which is intended to transfer heat between a fluid flowing through heat conductive deformable members and a fluid flowing through a conduit surrounded by the heat deformable members, has relevance to the heat exchange structure of Bone which transfers heat from

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a solid motor body to fluid traveling through passageways surrounding the interiorly located motor structure. None of the problems sought to be overcome by Molitor would be expected to exist in the motor heat exchange system of Bone. In view of the above, we are left to speculate why the skilled artisan would employ any of the features of the heat exchanger of Molitor in the system of Bone. The only reason we can discern is improper hindsight reconstruction of Appellant's claimed invention. In order for us to sustain the Examiner's rejection under 35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions or rationales to supply

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deficiencies in the factual basis of the rejection before us.

In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), rehearing denied, 390 U.S. 1000 (1968).

We are further of the opinion that, as asserted by Appellant, even assuming, arguendo, that if proper motivation were established for the Examiner's proposed combination, the resulting system would fall far short of meeting the specific requirements of the claims on appeal. The appealed claims set forth a specific structural relationship between the fluid-carrying conduit and the surfaces of the housing wall. The Examiner has provided no indication as to how and where the skilled artisan might have found it obvious to modify the teachings of Bone and Molitor to arrive at the specifics of the language of the various appealed claims which require either that the fluid conduit wall be distinct from the housing wall and embedded therein, or that the fluid conduit be disposed between the inner and outer surfaces of the housing wall. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make

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the modification obvious

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unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). Accordingly, since the Examiner has not established a prima facie case of obviousness, the rejection of independent claims 1, 2, 7, 8, 9, 10, and 22, and claims 3-6 and 23-29, dependent thereon, over the combination of Bone and Molitor is not sustained.

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In summary, we have not sustained the Examiner's 35
U.S.C.

§ 103 rejection of any of the claims on appeal. Thus, the
Examiner's decision rejecting claims 1-10 and 22-29 is
reversed.

REVERSED

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LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
PARSHOTAM S. LALL)	
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JFR:hh

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